

**REMARKS**

Review and reconsideration on the merits are requested.

Claims 1-6 were pending at the time of the rejection of December 4, 2003.

Claims 1 and 2 were rejected, but claims 3-6 were merely objected to.

While certain rejections were withdrawn in the Action, claims 1-2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 4-013128 (JP '128) in view of U.S. Patent 5,702,850 Nishioka et al (Nishioka). A partial translation of JP '128 is attached.

The rejection of claims 1-2, as now amended, is respectfully traversed.

The Examiner's position on the art is set forth in the Action and will not be repeated here except as necessary to an understanding of Applicants' traversal which is now presented.

**Claim Amendment**

Applicants essentially insert the words "image-forming" after the word "photosensitive" in the claims. See the specification at page 1, line 8 and page 3, lines 27-28.

Limitation to "image-forming" is a narrowing limitation in the claims.

Since the features which distinguish the present claims from the prior art are recited in amended claim 1, patentability is only discussed for amended claim 1.

JP '128 discloses a photochromic layer with a light response. However, photochromism is a phenomenon which essentially involves a reversible change of color upon light irradiation. However, photochromism in no fashion functions to record an image. The reason for this is that the formed images disappear when the irradiation with light is stopped. Specifically, as disclosed at page 7, right upper column of JP '128, the chromic film of JP '128 is used for

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/886,121

optical-related products such as a car window glass, a building window glass, etc., by being adhered thereto.

In contrast to JP '128, the photosensitive material of the present invention is used for recording an image. To clarify this difference between the present invention and JP '128, the claims of the present application have been amended as above explained.

With respect to Nishioka, as discussed in the previous response of August 4, 2003, Nishioka teaches image formation by color-developing a thermosensitive color image-forming layer upon heating, which is quite different from the present invention in involving uniform color-forming (applied as a filter).

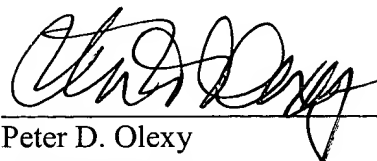
Applicants respectfully submit that one of ordinary skill in the art, referring to JP '128 and Nishioka, each of which are quite different in mechanism from the present invention, alone or in combination, would not suggest to one of ordinary skill in the art the present invention.

Accordingly, Applicants submit that claim 1, and all claims dependent therefrom, is/are not rendered obvious by the combination of JP '128 and Nishioka, and request withdrawal of the rejection.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/886,121

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Peter D. Olexy  
Registration No. 24,513

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: February 26, 2004